

Serial No. 09/760,136

Reply to Office Action dated May 5, 2005

REMARKS/ARGUMENTS

This Amendment Under 37 C.F.R. §1.116 is filed in response to the Official Action of May 5, 2005. Reconsideration and allowance of Claims 12, 16-20 and 24-27 remaining in the application in view of the foregoing amendment, the accompanying Declaration of Dr. Jeffrey Chambers and these accompanying remarks are respectfully requested.

The Office Action objected to Claim 12 because of a typographical error. In line 1, the word "adopted" has now been changed – adapted --.

Claims 12, 16-20 and 24-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 4,776,330 to Chapman et al. in view of U.S. Patent 6,132,389 to Cornish et al. This rejection is again respectfully traversed.

In rejecting the now-pending claims, the Examiner has asserted that Chapman et al. "discloses a guidewire capable of insertion into a vascular system of a patient during the course of a catheterization procedure". It is respectfully submitted that this contention is incorrect. Chapman et al. discloses a guidewire for supporting and centering a reamer used to core out a straight passageway through the neck and head portion of a femur bone and for then inserting a rigid tube into the cylindrical bore for stabilizing a fracture. Submitted herewith is a further Declaration of Dr. Jeffrey Chambers, a person of at least ordinary skill in the art of designing, fabricating and using intravascular guidewires. As is set out in paragraph 5 of this Declaration, the guidewire disclosed in the Chapman et al. reference would only be about 10-12 inches long whereas a typical intravascular guidewire is ten times that length. The Chambers Declaration further points out that an intravascular guidewire must be capable of traversing a tortuous path leading from a patient's groin into a selected cardiac chamber and even a selected cardiac artery or vein. The guidewire depicted in the Chapman et al. reference need only be advanced a matter of a few inches along a straight line path leading through the greater trochanter and the neck of the femur into its head.

Dr. Chambers further points out that, even if it is assumed for purposes of argument that the guidewire 25 in the Chapman et al. patent were made of the titanium,

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molybdenum, zirconium and tin alloy recommended for the bone stabilizing kit components, a person skilled in the art would not know from the teachings of the Chapman patent that an intravascular guidewire made from that same material would exhibit the requisite pushability, torqueability and malleability characteristics essential to a workable intravascular guidewire.

In his study of the Chapman et al. patent, Dr. Chambers notes that at several places within the patent document, there is an identification of the elements or components making up the kit to be used by an orthopedic surgeon in mending fractures of the femur. The patent does specifically teach that these kit components are preferably to be manufactured from Ti, Mb, Zr, Sn alloy because this alloy is "inert" and "resilient". Dr. Chambers, speaking as one of at least ordinary skill in the art relating to manufacture and use of intravascular guidewires, indicates that neither inertness nor resiliency is of particular advantage in the fabrication of such guidewires. See paragraph 4 of the Chambers Declaration submitted herewith.

In the "Remarks" filed with applicant's December 20, 2004 Amendment, applicant's attorney argued out that the Chapman et al. patent does not disclose a guidewire having approximately 78% titanium, 11.5% molybdenum, 6% zirconium and 4.5% tin by weight. The Examiner found this position "not persuasive", basing his contention on the statement made at column 13, lines 60-63 of the Chapman et al. patent. Here, it states that the short 3 or 4 in. guidewire 25 can be left in place as part of the implanted elongated bone implant and, therefore, the guidewire must be of the same alloy used for the kit components. Dr. Chambers refutes this flawed logic in paragraph 7 of his Declaration. His reading of the specification at column 13, line 36 does not lead him to conclude that the guidewire 25 must be made from a titanium, molybdenum, zirconium and tin alloy merely because it may be left in the patient along with other components made of that alloy. Dr. Chambers supports his position by referring to column 17, lines 20-24, of the Chapman specification where it is stated that "**conventional** fixation pins" can be implanted. This suggests that components, other than those made of titanium, molybdenum, zirconium and tin alloy, can be used in conjunction with the kit components that are made from this alloy. Hence, there is no reason to conclude that the

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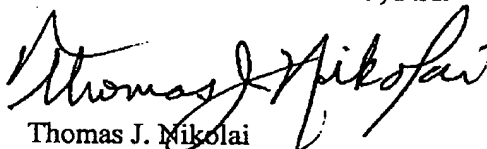
guidewire described in the Chapman et al. patent, but not identified as a kit component, must be of the same alloy as the kit components.

For the reasons set forth above, it is again submitted that independent Claims 12 and 20 define an invention which would not have been obvious within the meaning of 35 U.S.C. §103(a) and that, therefore, the rejection to independent Claims 12 and 20 should be withdrawn. Since the remaining claims in the application depend either directly or indirectly from allowable Claims 12 and 20, those dependent claims are also in condition for allowance. Thus, a Notice of Allowance is respectfully requested.

In the event that the Examiner should continue his rejection, it is respectfully requested that the presently submitted Chambers Declaration be included in the record for consideration by the Board of Appeals and Interferences.

Respectfully submitted,

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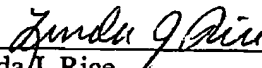
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment in response to the Final Office Action dated March 5, 2005, in application Serial No. 09/760,136, filed on January 12, 2001, of Stephen Nuss entitled "Titanium Molybdenum Alloy Guidewire" is being sent via facsimile transmission addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 5, 2005 to Fax No. 703-872-9306 (37 CFR 1.8a).

Date of Signature: July 5, 2005.



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